

REMARKS

Claims 1-21, 31-40, and 50 are pending in this application. Claim 52 is canceled without prejudice or disclaimer to the subject matter contained therein. In light of the amendments and remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 1-21, 31-40, 50, and 52 under 35 U.S.C. § 112, first paragraph; rejected claims 1-21 under 35 U.S.C. § 112, second paragraph; rejected claims 1, 5-12, 15-21, 31-32, 37-40, 50, and 52 under 35 U.S.C. § 103(a) as being unpatentable over *Hecht* (USP 6,594,406); rejected claims 2 and 33 under 35 U.S.C. § 103(a) as being unpatentable over *Hecht* in view of *Shiigi* (USP 6,304,898); and rejected claims 3-4, 13-14 and 34-36 under *Hecht* in view of *Morgan* (USP 5,428,805). Applicants respectfully traverse these rejections.

Objections to the Specification

In response to the Examiner's objection to the specification, by this Amendment, Applicants have amended the specification to include definitions of the acronyms. Based upon this Amendment, it is respectfully requested that the outstanding objection be withdrawn.

Claim Rejections - 35 U.S.C. § 112, First Paragraph

With regard to the Examiner rejection of claims 1-21, 31-40, 50, and 52 under 35 U.S.C. § 112, first paragraph, by this amendment, Applicants have amended the claims to remove the objected to subject matter. It is respectfully submitted that these amendments are being made without conceding the propriety of the Examiner's rejections, but merely to timely advance prosecution of the present application. Based upon these amendments, it is respectfully requested that the outstanding rejections be withdrawn.

Claim Rejections - 35 U.S.C. § 112, Second Paragraph

With regard to the Examiner rejection of claims 1-21 under 35 U.S.C. §112, second paragraph, by this amendment, Applicants have amended the claims to remove the objected to subject matter. It is respectfully submitted that these amendments are being made without conceding the propriety of the Examiner's rejections, but merely to timely advance prosecution of the present application. Based upon these amendments, it is respectfully requested that the outstanding rejections be withdrawn.

Claim Rejections - 35 U.S.C. § 103(a) - Hecht

In support of the Examiner's rejection of claim 1, the Examiner admits that *Hecht* fails to teach or suggest an imaginary position surface being imaginary in the system in as much as the position-coding pattern is never present in it is entirety on any

base. However, the Examiner fails to provide any reference that cures the deficiencies of the teaching of *Hecht*.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

By this Amendment, Applicants have amended claim 1 to recite "a position-coding pattern which codes absolute coordinates of a total set of positions, wherein one or more subsets of said position-coding pattern is provided on said base, wherein the total set of positions coded by the position-coding pattern specifies unique positions on an area greater than the area of any practically useable base." It is respectfully submitted that, as admitted by the Examiner, *Hecht* fails to teach or suggest this claim element. As the Examiner has failed to provide any further combinable reference that teaches or suggests this claim element, and as the Examiner has failed to provide reference that teach or

suggest all of the claimed elements, it is respectfully submitted that the rejection fails to establish *prima facie* obviousness. As such, claim 1 is not obvious over *Hecht* and Applicants request the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2-11 are allowable for the reasons set forth above with regard to claim 1 based upon their dependency on claim 1. It is further respectfully submitted that claims 12, 31, 37, and 50 contain elements similar to those discussed above with regard to claim 1, and thus claims 12, 31, 37, and 50, together with claims dependent thereon, are allowable for the reasons set forth above with regard to claim 1.

Request for Interview

Applicants submit herewith a Request for Interview. Prior to the Examiner's formal consideration of this Reply, Applicants respectfully request the Examiner contact the undersigned to conduct an Interview.

Conclusion

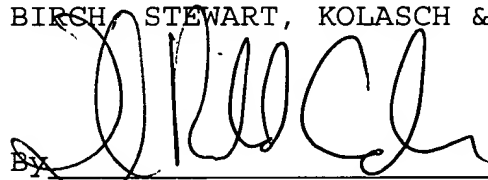
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicants respectfully petition for a one (1) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the amount of \$110.00 in payment of the extension of time fee is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

A handwritten signature in black ink, appearing to read "D. Anderson", is written over a horizontal line.

D. Richard Anderson, #40,439

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